

REMARKS

Reconsideration is respectfully requested.

I. Status of the Claims

The Office Action notes that claims 1-29 are pending. However, claims 24 and 25 were canceled during the international stage, and the remaining claims were renumbered as claims 1-27. In the present listing of claims, Applicants have indicated that claims 24 and 25 were previously canceled and have retained the numbering used in the Office Action.

Claims 1-3, 19-21, 26, and 28 have been amended to delete subject matter recited in the alternative, namely derivatives, analogs, and polymorphs of the claimed compounds, oxo and thio substituents at R¹³ and R¹⁴, and carboxylic, sulfonic, and phosphoric acids and their derivatives at R¹-R¹². Claims 1-12, 15-21, 23, 26, 28, and 29 have been amended merely for clarification. Accordingly, no new matter has been added.

Claim 14 has been canceled without prejudice.

Claims 1-13, 15-23 and 27-29 are pending. Because claims 5-13, 15-23, and 27-29 have been withdrawn from consideration by the Examiner, only claims 1-4 and 26 are presently at issue.

II. Restriction Requirement

In the Office Action dated January 3, 2007, the previous Examiner issued a restriction requirement identifying three inventions groups as exemplary of distinct inventions within claims 1-4 and 14. In response, Applicants traversed the requirement and provisionally elected Group I, claims 1-4 and 14, having the variables defined as in the Office Action.

In this Action, the present Examiner acknowledges the election of Group I but has also examined the entire scope of claims 1-4 and 14 and joined claim 26 to the elected claims.

Applicants gratefully acknowledge the revision of the original restriction requirement and note that the elected subject matter encompasses the entire scope of claims 1-4, 14, and 26.

The Examiner maintains that the restriction of claims 5-13, 15-25, and 27-29 is proper “because the claims do not have a common structural feature that defines a contribution over the prior art. Each of the groups set forth in the previous Office Action represents either a separate process or discrete heterocyclic ring system” Office Action, page 3, lines 4-8.

However, this is not true. For example, claims 5-13 recite the use of the compounds and pharmaceutical compositions of claims 1 and 3 in the preparation of medicaments. Claims 15-18 recite methods of treating certain disorders by administering the compounds of claim 1. Claims 19-23 recite processes for preparing the compounds of claim 1. Claims 26-28 recite novel intermediates having the same benzo[d]isothiazolo[3,2-a]indole-S,S-dioxide core as the compounds of claim 1. Each of these claims shares a common structural feature with the elected claims, namely the core of the compounds of formula (I).

Furthermore, the unity of invention standard permits in a single application claims directed to a product, uses of the product, processes specifically adapted to manufacturing the product, and intermediates having a closely related chemical structure. *See* MPEP § 1850.III.A and C.

In addition, any prior art that may read on claim 24 from the International application as filed does not destroy unity of invention in the present application because the intermediates of claim 24 do not share the same common structural feature as the compounds of claim 1. Moreover, claims 24 and 25 were canceled during the international stage and have never been at issue in the present application.

Accordingly, Applicants respectfully submit that restriction is improper and request that all the pending claims be considered and examined together.

III. Claim Objections

Claim 14 has been objected to as being a substantial duplicate of claim 1. Without conceding the validity of the objection, claim 14 has been canceled. Therefore, the objection is moot.

IV. Claim Rejections under 35 U.S.C. § 112

Claims 1-4 and 14 have been rejected for lack of enablement. The Examiner contends that the specification does not reasonably provide enablement for derivatives, analogs, and polymorphs of the claimed compounds. Without conceding the validity of the rejection, the claims have been amended to remove reference to derivatives, analogs, and polymorphs.

Claims 1-4, 14, and 26 have been rejected as indefinite for the reasons set forth in the Office Action. In response, claims 1 and 26 have been amended to delete the word “general” from the reference to formula (I); claims 1, 2, and 3 have been amended to remove reference to derivatives, analogs, and polymorphs of the claimed compounds; claims 1 and 26 have been amended to delete “oxo”, “thio”, “carboxylic acid and its derivatives”, “sulfonic acid and its derivatives”, and “phosphoric acid and its derivatives” from the list of substituents at R₁-R₁₂; claim 1 has been amended to replace “heterocyclalkyl; optionally” with “or heterocyclalkyl; or” and to replace “and represents may be either linear or branched carbon chain” with “and may represent either a linear or branched carbon chain”; claims 2-4 have been amended to remove the dash before the numbered claim; and claim 2 has been amended to add an “and” before the last compound listed.

Claim 14 has been rejected for improperly referencing subject matter. Claim 14 has been canceled, rendering the rejection moot.

Applicants submit that all the bases for the rejections under 35 U.S.C. § 112 have been addressed and respectfully submit that the rejections be withdrawn.

Applicants note that they have also amended the withdrawn claims where the above rejections may be applicable.

CONCLUSION

In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance. If there are any issues remaining that the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: August 30, 2007

Respectfully submitted,

By Jonathan Harris
Jonathan Harris

Registration No.: 60,473
DARBY & DARBY P.C.
P.O. Box 770
Church Street Station
New York, New York 10008-0770
(212) 527-7700
(212) 527-7701 (Fax)
Attorneys/Agents For Applicant